

## REMARKS

Claims 12-25, of which claim 12 is currently amended, and new claim 26 appear in the application for the Examiner's review and consideration. Claim 12 is amended for clarification. Claim 26 is a reproduction of claim 12 but omitting the language that was objected to under section 112. The amendments to claim 12 and the features of new claim 26 are supported by both the original claims and the specification. As no new matter has been introduced, Applicants respectfully request that the amendments be entered at this time.

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Although the term "plastic coated cellulosic paper" is widely used and readily understood in the art to describe a certain type of coated paper that is mainly used for children's books, posters, signs and shipping tags (*see* [0013]) and would not be confused with the present plastic-paper-plastic laminate sheeting, claim 12 is amended in the interest of expediting the prosecution of this application. Claim 12 now recites that a dilatable container product made from the present laminate sheeting has enhanced tear and burst strength compared to that of dilatable containers made from plastic coated cellulosic papers that are not laminated. The amended claim 12 compares and clearly distinguishes the features of the present invention from those of conventional plastic coated paper products, such as that of Redmond. Accordingly, this claim rejection should be withdrawn.

The rejection of claim 12 under 35 U.S.C. § 112 made of record in paragraph 13 of Paper 6 is repeated for the reasons stated in paragraph 5 of the Office Action. In response, claim 12 has been amended as suggested by the Examiner, and the rejection should be withdrawn.

As noted, new claim 26 is not subject to this rejection and is written in a manner that is in full compliance with section 112. The improved properties of the container result from the claimed structure and do not necessarily have to be recited in the claims.

The 35 U.S.C. § 103(a) rejection of claims 12-20 over Redmond (U.S. Patent No. 3,986,640) in view of Finestone *et al.* (U.S. Patent No. 6,083,580) is repeated for the reasons stated in paragraph 6 of the Office Action. In particular, the Examiner states that the claim recitation added to claim 12 in the previous response (Paper 8, October 1, 2003) cannot be treated on its merits because of the new § 112, second paragraph, rejection. Since this § 112

rejection should be overcome in light of the current claim amendment, the claim recitation should be considered on its merits.

Applicants respectfully submit that the prior art does not render claims 12-20 obvious under § 103. Applicants likewise traverse the repeated 35 U.S.C. § 103(a) rejection of claims 21-25 over Redmond in view of Finestone, and would like to clarify the arguments submitted in the previous response of October 1, 2003.

As explained in the previous response, Redmond discloses a packaging material for containing flowable substances. The packaging material includes a base made of a sheet of relatively stiff material such as cardboard, fiberboard, paperboard or plastic (col. 4, lines 46-49). When this base has the characteristic of being absorbent or easily soiled, its surface forming the exterior of the package may be coated with a sealant in order to protect the outer package surface from being soiled (col. 4, line 63 to col. 5, line 2). Such sealant, however, "should be sufficiently weak, when the package is bent, so as to avoid interference with the rupture of the base" (col. 5, lines 2-6). Thus, it must break or rupture when the relatively stiff base is bent or folded along the cut pattern on its surface. The opposite surface of the base may also be covered with a sealing layer, preferably a foil (col. 5, lines 7-9), which contacts the flowable substance that is being packaged.

Because the Redmond package dispenses the enclosed product by bending or folding the package along the pre-cut pattern on the relatively stiff base material, it is critical that the sealant would also break open when the package is bent (Abstract; col. 5, lines 2-6). Accordingly, the sealant must be sufficiently weak to yield to such a bending force and to break open and dispense the packaged product. A wax, a foil, or suitable plastic having such breakability should be used (col. 3, lines 38-40). While these coatings are suitable for Redmond's purpose, they are not laminated to the paper, nor would there be any reason to laminate them since lamination would strengthen the construction and Redmond requires that the film must be able to rupture or break.

In contrast, the synthetic oriented plastic material of the present laminate sheeting is selected specifically for its substantially increased tensile strength compared to an unoriented film, and would be resistant to the kind of force used to open the Redmond package (*see* [0032]; [0046]). Furthermore, it is laminated to the paper by a cold lamination process to retain as much of the strength of the oriented plastic film in the final laminate as possible. The fact that the Redmond sealant and the present reinforcing film are used for different

purposes further stresses the difference between these disclosures. While the sealant is simply used in Redmond to protect the base material from soiling or contacting the packaged product (col. 4 line 63 to col. 5, line 14), the reinforcing film of the present invention serves a completely different function of imparting high strength to the paper sheeting and the laminate ([0017]).

Therefore, Redmond does not render the present claims obvious because, even though both inventions feature combinations of different materials, the resulting constructions of such materials have fundamentally different properties and are used for different purposes. The use of an easily ruptured material for contact-protection purposes (to prevent contact with soil or enclosed product) does not render obvious the use of a high-strength material chosen for its sturdiness, merely based on the fact that both materials are used to form composite materials.

Applicants respectfully disagree with the Examiner's statement that "the structure taught by Redmond that enables the package of Redmond to be 'an easy opening package' . . . has nothing to do with the structure claimed in the instant application" (p. 4, Office Action). The teaching of Redmond that its package is easy-opening may be "a teaching in regard to the manner in which the package is intended to be employed" (p. 5, Office Action), but it also pertains to the essential nature of the Redmond package that is clearly and fundamentally different from that of the present invention. Because its sealant must be ruptured when the package is bent to dispense the enclosed product, Redmond specifically teaches that the sealant must be sufficiently weak to be ruptured by a bending or folding motion that pulls the sealant apart (col. 5, lines 2-6). The present invention, in contrast, seeks to prevent such easy rupturing or breakage by incorporating a synthetic oriented plastic material that can withstand the force exerted by a bending or folding motion. Hence, the disclosure that a package made according to Redmond must be easy-opening while the one made with the present laminate sheeting must have high strength and tear resistance does not only concern the manner each package is intended to be employed, but manifests the critical structural difference of the packages made according to each invention.

The Examiner's statements that the "package taught by Redmond and Finestone . . . would be 'easy opening' with a readily available knife or pair of scissors" and that "the method that one uses to open the package of Redmond is irrelevant to the patentability of the package that is claimed in the instant application" (pp. 4-5, Office Action) appear to be based

on misinterpretation of the Redmond invention and the different nature of the various packages. Certainly, any package could be "easy opening" when necessary tools are used to facilitate the opening of the package. Applicants' characterization of the Redmond package as "easy opening," however, pertains to the strength and nature of the package materials that allows the package to be readily ruptured upon exertion of certain motions or forces.

Redmond's package would not be suitable for its intended purpose if it had to be opened with additional tools. In comparison, the package made with the present laminate sheeting can be characterized as not "easy opening" because it is designed to withstand such forces. Thus, the Examiner's statement that Applicants' characterization of the Redmond package as easy opening "has nothing to do with the structure claimed in the instant application" (p. 4, Office Action) is incorrect, because such description of the nature of the Redmond package explains its fundamental structural difference from the present package.

Also, to assert a position of "easy opening" according to the office action clearly ignores the express language of all claims, which state that a dilatable container product made from the laminate sheeting has moisture resistance and enhanced tear and burst strength compared to the tear and burst strength of dilatable containers made from plastic coated cellulosic papers that are not laminated. It is believed that the current language of these claims now will be given appropriate weight since the section 112 rejection has been overcome.

Furthermore, a person skilled in the art would have no motivation to modify the Redmond package by replacing its sealant with a more durable material, because such modification would defeat the entire purpose of the Redmond invention. Redmond has specifically chosen materials with particular characteristics to be used as its sealant. These materials are specified to be "sufficiently weak" so as "to avoid interference with the rupture" of the base (col. 5, lines 2-5). Therefore, a skilled artisan would have no reason to replace the Redmond sealant with a material that is known to have enhanced strength and tear resistance. It only appears that the Examiner is using improper hindsight in combining the prior art references and suggesting that a skilled artisan would be motivated to modify the sealant of Redmond in light of Finestone.

Applicants would again like to draw the Examiner's attention to the disclosure made in Redmond that teaches away from the present invention. Redmond discloses that "[a] container made with thin sheets, sometimes laminated with foil or other material . . . are often

difficult to open" and to open such package "the sheets must be ripped through the sealed edge and across the [package]" (col. 1, lines 46-58). The package Redmond teaches against, constructed from thin sheets laminated with other material, is exactly the kind of package covered by the claims of the present application. Accordingly, a person skilled in the art would have no motivation to modify the Redmond package in light of Finestone and incorporate the elements that Redmond teaches against to reach the present invention. Except for the use of combined dissimilar materials, a package made with the present laminate sheeting is structurally and functionally different from the Redmond package, and the prior art references simply do not support a conclusion of obviousness under § 103. Applicants therefore respectfully request that all § 103 rejections be withdrawn.

The office action summarily dismisses the Rule 132 declaration of Inventor Arnold Finestone by stating that it only provides conclusions. This statement is incorrect, since Dr. Finestone has provided testimony evidence as to why the present invention is unexpectedly improved over the cited Redmond reference. In particular, Dr. Finestone has emphasized the differences between a container made of a plastic/paper/plastic laminate, as presently claimed, compared to one of a paper or cardboard substrate that is coated with plastic as per Redmond. Paragraphs 3, 4, 5 and 6 of Dr. Finestone's declaration support the attorney arguments that were made in the prior response. Rather than being a "rehash" as alleged in the office action, the Finestone declaration presents testimony evidence that the Examiner cannot dismiss so easily.

Dr. Finestone also explained that the strength of an oriented film is much greater than that of a coating, and the present invention seeks to preserve this strength by the way in which the oriented film is laminated to the paper layer. In fact, the present invention utilizes not one but two oriented plastic material films, one on each surface of an interior paper sheet. The resulting construction enables strong yet lightweight containers to be made for handling all different types of semi-solid and liquid fluids without concern of leakage or rupture. This is supported by paragraphs 2, 7 and 8 of Dr. Finestone's declaration.

The office action relies on the combination of the Finestone patent and the Redmond patent in an attempt to reject the claims. Dr. Finestone has presented opinion evidence in paragraphs 9, 10 and 11 of his declaration that demonstrates why one of ordinary skill in the art would not combine those references due to their disparate teachings. Furthermore, there is no logical way to perform a comparison test between the prior art and the presently claimed

invention, since Redmond expressly teaches that the plastic coating must be sufficiently weak when the package is bent so as to avoid interference with the rupture of the base, and to prepare a comparative product where an oriented polymer film is substituted for the plastic coating would go against the teachings of Redmond. As one of ordinary skill in the art would not be taught how to make the present invention based on the combination of the Redmond and Finestone patents, all rejections based on that combination of patents have been overcome and should be withdrawn.

In view of the foregoing, it is believed that the entire application is now in condition for allowance, early notification of such would be appreciated. Should the Examiner not agree, a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the claims and application.

Date

4/19/04

Respectfully submitted,

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